

REMARKS

I. Introduction

Claims 1 and 5-12 are pending in the present application after cancellation of previously withdrawn claim 13. Claim 1 has been amended. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 1, 5 and 7-12

Claims 1, 5 and 7-12 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by United States Patent No. 6,302,190 ("Clamp"). For at least the following reasons, Applicants respectfully submit that pending claims 1, 5 and 7-12 are patentable over Clamp.

To anticipate a claim under §102(b), each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To the extent that the Examiner may be relying on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

In support of the rejection, the Examiner cites col. 2, l. 31-34 of Clamp, which section indicates that "the cover plate 34 is welded or otherwise affixed to the channel 40 in a fluid sealing arrangement," and the Examiner contends that welding the two component parts results in "a one-piece cooling tube integrally formed in the bottom section." (Office Action, p. 6). In this regard, Applicants respectfully submit that the Examiner's contention is inherently illogical: how can a cooling tube made of two component parts be "a one-piece cooling tube"? In any case, in order to expedite prosecution of the present application, Applicants have further amended independent claim 1 to recite that "the entire bottom section including the one-piece cooling tube

is formed of a single structural component without joining seams." This amended feature is clearly supported by the disclosure in the original specification that the entire bottom section is formed in a single casting step (p. 2, l. 9-11). To the extent the Examiner acknowledges that Clamp discloses using two discrete structural components (34 and 40) which are welded together to produce a single resulting piece, it is clear that Clamp does not teach or suggest that "the entire bottom section including the one-piece cooling tube is formed of a single structural component without joining seams."

For at least the foregoing reasons, Applicants submit that claim 1 and its dependent claims 5 and 7-12 are not anticipated by Clamp.

III. Rejection of Claim 6

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,302,190 ("Clamp") in view of U.S. Patent 4,652,970 ("Watari"). For the following reasons, Applicants respectfully submit that claim 6 is patentable over the combination of Clamp and Watari.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements" in the manner claimed. See KSR Int'l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112;

emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claim 6 depends on claim 1. As noted above, Clamp clearly does not anticipate parent claim 1. In addition, Watari clearly does not remedy the deficiencies of Clamp as applied against parent claim 1. Accordingly, even if one assumed for the sake of argument that some motivation existed for combining the teachings of Clamp and Watari, with which assumption Applicants do not agree, the overall teachings of Clamp and Watari would not render obvious claim 1 and its dependent claim 6. Therefore, the obviousness rejection of claim 6 should be withdrawn.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that all pending claims 1 and 5 to 12 of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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